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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,283	08/18/2003	Wataru Kakinoki	36856.1112	2453

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MURATA MANUFACTURING COMPANY, LTD. C/O KEATING & BENNETT, LLP 8180 GREENSBORO DRIVE SUITE 850 MCLEAN, VA 22102		

EXAMINER	
LEVI, DAMEON E	

ART UNIT	PAPER NUMBER
2841	

NOTIFICATION DATE	DELIVERY MODE
09/21/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/642,283

Applicant(s)

KAKINOKI ET AL.

Examiner

Dameon E. Levi

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/14/2007(Response).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____



DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,5-10, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francis et al. (US 5,011,010) in view of Farag et al. (US 6,844,872).

Regarding claim 1, Francis et al. discloses a card-like computer device comprising: a sheet member (column 4, lines 10-23 describe the insertion of sheet member) including a draw-processed sheet member (column 4, lines 10-23 describe the insertion of sheet member) treated with coloring or marking; and a transparent or translucent cover case (element 10 in figures 5-7); wherein the sheet member (column 4, lines 10-23 describe the insertion of sheet member) includes an upper portion (printed material located in element 50, see column 4, lines 10-23) and three side portions (portion at element 13, portion opposite element 13, portion of element 16 in figures 5-7); each of the upper portion (printed material located in element 50 in figures 5-7, see column 4, lines 10-23) and the three side portions (portion at element 13, portion opposite element 13, portion of element 16) of the sheet member (column 4, lines 10-23 describe the insertion of sheet member) is connected to one another by rounded joint portions (element 16 in figures 5-7); and the sheet member (column 4, lines 10-23 describe the insertion of sheet member) is fitted into the cover case (element 10 in figures 5-7) such that

the sheet member (column 4, lines 10-23 describe the insertion of sheet member) extends in close contact with an inner surface of the cover case (element 10 in figures 5-7).

Francis et al. does not disclose the sheet member is a three-dimensional member; each of the three side portions extends substantially perpendicularly downward from the upper portion; and the rounded joint portions connect the three side portions to the upper portion.

Farag et al. discloses the sheet member (element 90 in figure 4) is a three-dimensional member; each of the three side portions (left or right portions and both sides of 90 in figure 4) extends substantially perpendicularly downward from the upper portion; and the rounded joint portions connect the three side portions to the upper portion (the rounded joint appears to connect the three sides to upper portion, see figure 4).

Accordingly, it would have been obvious for one ordinary skill in the art at the time of the invention to have provided the three dimensional member as taught by Farag et al. in the devices of Francis et al. for the benefit of keeping the member in place.

Regarding claim 5, Francis et al. discloses the sheet member comprises paper (see column 4, lines 10-23).

Regarding claim 7, Francis et al. discloses in figure 1, the cover case and the sheet member are firmly fixed to each other (Fig 1).

Regarding claim 8 Francis et al. discloses a card-like computer peripheral device comprising: a frame (elements 47, 49, 53, in figures 5-7) having a groove (element 49 in figures 5-7) formed along at least one side thereof; a sheet member (column 4, lines 10-

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23 describe the insertion of sheet member) including a draw-processed sheet member (column 4, lines 10-23 describe the insertion of sheet member) treated with coloring or marking, and a transparent or translucent cover case (10); wherein the sheet member (column 4, lines 10-23 describe the insertion of sheet member) includes an upper portion (printed material located in element 50, see column 4, lines 10-23) and three side portions (portion at element 13, portion opposite element 13, portion of element 16); each of the upper portion (printed material located in element 50, see column 4, lines 10-23) and the three side portions (portion at element 13, portion opposite element 13, portion of element 16) of the sheet member is connected to one another by rounded joint portions (element 16 in figures 5-7); and at least one of the three side portions (portion at element 13, portion opposite element 13, portion of element 16) of the sheet member is inserted into the groove (element 49 in figures 5-7) of the frame and the transparent or translucent cover case (element 10 in figures 5-7) and the frame are firmly fixed to each other so as to sandwich and hold a portion of the sheet member (column 4, lines 10-23 describe the insertion of sheet member), including said at least one side. Francis et al. does not disclose the sheet member is a three-dimensional member; each of the three side portions extends substantially perpendicularly downward from the upper portion; and the rounded joint portions connect the three side portions to the upper portion.

Farag et al. discloses a sheet member (element 90 in figure 4) is a three-dimensional member; each of the three side portions (left or right portions and both sides of 90) extends substantially perpendicularly downward from the upper portion; and the rounded joint portions connect the three side portions to the upper portion (it appears rounded joint connect the three sides to upper portion, see figure 4).

Accordingly, it would have been obvious for one ordinary skill in the art at the time of the invention to make devices of Francis et al. to have three dimensional member as taught by Farag et al. for the benefit of keeping the member in place.

Regarding claim 9, Francis et al. disclose the sheet member comprises at least one flange (element 24 in figures 5-7) at the front thereof such that the flange is sandwiched and held by the cover case and the frame (elements 47, 49, 53 in figures 5-7,).

Regarding claim 10, Francis et al. discloses the instant claimed invention except Francis et al. does not disclose a circuit board, wherein the circuit board is sandwiched and held by the appearance protective case and the frame such that the sheet member and the frame lie in contact with opposing surfaces of the circuit board.

Farag et al. discloses a circuit board (element 19 in figures 2), wherein the circuit board is sandwiched and held by the appearance protective case and the frame such that the sheet member and the frame lie in contact with opposing surfaces of the circuit board (circuit board is held within case).

Accordingly, it would have been obvious for one ordinary skill in the art at the time of the invention to have included a circuit board as taught by Farag et al. in the devices of Francis et al. for the purpose of mounting essential components for communicating with electronic devices.

Regarding claim 14, Francis et al. discloses, the steps (elements 49, 50 in figures 5-7) are formed in the groove of the frame.

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Claims 2-4, 6, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francis et al. (US 5,011,010) in view of Farag et al. (US 6,844,872) and further in view of Nakayama (US 6,413,630).

Regarding claim 2, Francis et al. discloses all the elements of the appearance protective case assembly as described above respect to claim 1 except, Francis et al. does not disclose the sheet member includes a decorative film comprising resin.

Nakayama discloses the decorative film comprising resin (see column 1, line 20 and further)

Accordingly, it would have been obvious for one ordinary skill in the art at the time of the invention to include decorative film comprising resin as taught by Nakayama in the device of Francis et al. for the as resin is easily moldable and lightweight for forming portions of electronic device housings.

Regarding claims 3 and 4, Francis et al. discloses all the elements of the card-like computer as described above with respect to claim 2 except, Francis et al. does not disclose the decorative film comprises a transparent film having a rear or front surface treated with coloring or marking.

Nakayama discloses a decorative film comprising a transparent film (see abstract) having a rear/front surface treated with coloring or marking.

Therefore, it would have been obvious for one ordinary skill in the art at the time of the invention to comprise a transparent film having a rear/front surface treated as taught by Nakayama in the device of Francis et al. for aesthetic purposes.

Regarding claim 6, Francis et al. and Farag et al discloses the instant claimed invention except the sheet member comprises a metal sheet

Nakayama discloses a sheet member comprising a metal sheet (see abstract).

Accordingly, it would have been obvious for one ordinary skill in the art at the time of the invention to provide a metal sheet as taught by Nakayama in the device of Francis et al and Farag et al for the benefit of protecting the elements housed therein.

Regarding claim 11, Francis et al. discloses the instant claimed invention except an upper metal cover firmly fixed to the cover case and the frame and a lower metal cover firmly fixed to the frame such that at least a colored or marked pattern printed on the sheet member is exposed.

Nakayama discloses disclose an upper metal cover (see abstract) firmly fixed to the cover case and the frame and a lower metal cover firmly fixed to the frame such that at least a colored or marked pattern printed on the sheet member is exposed.

Therefore, it would have been obvious for one ordinary skill in the art at the time of the invention to make devices of Francis et al. to have an upper metal cover as taught by Nakayama for the purpose of decorating the securely housing the components therein.

Regarding claim 13, Francis et al. discloses the instant claimed invention except the appearance protective case wherein the decorative film is made of one of polystyrene, acrylonitrile-butadiene-styrene copolymer, acrylonitrile-styrene copolymer, polyvinyl chloride, methacrylic resin, cellulosic resin, polycarbonate, polyethylene, polypropylene, polyvinylidene chloride, polyacetal, polyamide, and fluorocarbon resin. Nakayama discloses the appearance protective case wherein the decorative film is made of one of polystyrene, acrylonitrile-butadiene-styrene copolymer, acrylonitrilestyrene copolymer,

polyvinyl chloride, methacrylic resin, cellulosic resin, polycarbonate, polyethylene, polypropylene, polyvinylidene chloride, polyacetal, polyamide, and fluorocarbon resin.

Accordingly, it would have been obvious for one ordinary skill in the art at the time of the invention to have used one of the chemicals above as taught by Nakayama in making the device of Francis et al. as such materials are widely used as coating materials for electronic device housings.

Response to Arguments

Applicant's arguments filed 06/14/2007 have been fully considered but they are not persuasive. In response to applicant's arguments that the prior art does not teach a card-like peripheral device, the recitation of "a card-like peripheral device" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) And *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In response to applicant's argument that the prior art combination of record is nonanalogous

art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the field of endeavor of relates to devices used as, and are connected to, computer peripheral devices.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dameon E. Levi whose telephone number is (571) 272-2105. The examiner can normally be reached on Mon.-Thurs. (9:00 - 5:00) IFP, Fridays Telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information Regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dameon E Levi
Examiner
Art Unit 2841

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PRIMARY EXAMINER